<center>REMARKS</center>

<center>*Telephone Interview Summary*</center>

The Applicants representatives, Dion M. Bregman and Shawn Glidden participated in a telephone interview with the Examiner on February 4, 2004. The following claim amendments were discussed during the interview. More particularly, the Applicants discussed the differences between the present invention and U.S. Patent No. 5,737,539 to Edelson *et al.* (hereinafter "Edelson"), as pointed out below. Applicants emphasized that the present invention is focused on automatically "pushing" information to a portable electronic device, such as during HotSync,® as opposed to "pulling" information to an electronic device, as disclosed in Edelson and Bennahum. As described in detail below, Edelson requires the user to request an update, whereas the present invention operates in a synchronization manner to automatically update the portable electronic device with medical data, such as the latest formulary lists, drug-drug interactions, etc. This allows users to always have the latest medical data available with them at the point-of-care.

The Applicants also discussed claim 27, 31, and 34 with the Examiner. The Applicants clarified the Examiner's confusion regarding claim 27 by pointing out that it is preferred that the advertising occur on a user's desktop while the portable electronic device is updating. However, it is also contemplated that the advertising could occur elsewhere, such as the screen of the portable device. The Applicants also informed the Examiner of the importance of the subject matter of claim 34. Under ethical considerations, a physician should not receive gifts of a substantial dollar amount. Therefore, as claimed, it is important that the sponsoring entity retain ownership of the portable electronic device and only provide the use of the portable electronic device to physicians. The Examiner noted the distinguishing features, but reserved judgment until he reviewed this response in detail.

The Office Action mailed December 17, 2003, was marked as both Final and Non-final. The Examiner stated that this office action is non-final.

<center>*Arguments*</center>

The declaration filed on September 22, 2003, under 37 C.F.R. § 1.131 overcame the ParkStone, Menduno, and med-I-nets references. The Examiner also rejected all pending claims, claims 1-26, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,539 to Edelson *et al.* (hereinafter "Edelson") in view of the article by Bennahum,

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David, "Docs for Docs" (hereinafter "Bennahum").

Applicants have amended independent claims 1, 12, 17, and 22 and added new claims 27-44. No new matter has been added. Support for the new claims can be found throughout the specification, drawings, and claims as originally filed. After entry of this amendment, the pending claims are: claims 1-44.

Claim Rejections - 35 USC § 103

The Examiner has rejected claims 1-26 under 35 U.S.C. § 103(a) as being unpatentable over Edelson in view of the article by Bennahum.

To establish a prima facie case of obviousness, three basic criteria must be met, namely:

1)   There must be some <u>suggestion or motivation</u>, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, <u>to</u> <u>modify</u> the reference <u>or to combine</u> reference teachings;

2)   There must be a <u>reasonable expectation of success</u>; and

3)   The prior art reference (or references when combined) <u>must teach or</u> <u>suggest all the claim limitations</u>. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.[1]

Rejected claims 1-26 contain four independent claims, namely claims 1, 12, 17, and 22. All of the independent claims have been amended to further clarify the invention.

The Examiner alleges that:

> Edelson discloses A method for distributing medical data to medical personnel (see abstract), said method comprising the steps of: storing medical data in a database (col. 8, lines 4-31); and periodically communicating selected medical data between said database and an electronic device to establish a medical data distribution system (col. 7, lines 10-31).[2]

The Examiner also alleges that:

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[1]   *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

[2]   *See* Office Action, mailed December 17, 2003, pgs. 2-3.

Edelson does not explicitly disclose a data distribution system subsidized by sponsoring entities. However, Bennahum discloses a data distrubution system subsidized by sponsoring entities (page 3, paragraphs 1 and 2).[3]

This rejection is respectfully traversed. Edelson discloses a prescription creation system in which a user, such as a doctor, takes an action and <u>requests</u> updated data be sent to the user. For example, Edelson discloses that the host computer facility compiles data "<u>in response to a call</u> from the user device."[4] Moreover, Edelson discloses "[a] further important function of host computer facility 206 is to <u>retrieve</u>... patient record[s]... and to deliver them to users... <u>in response to the user's call for that record</u>."[5] In other words, Edelson discloses a 'pull' method where a user requests data from a server or host computer facility. Similarly, Bennahum discloses an electronic database for collecting and maintaining data on patients' medical records. Bennahum, like Edelson discloses users requesting or 'pulling' data from this electronic database. For example, Bennahum discloses that "the doctor would just call up the medical information," "[t]he doctor pulling down a record," and "doctors can search for disease and treatments."[6]

In contrast, the present independent claims require automatically providing updates to a portable electronic device <u>in response to a connection signal</u> between the portable electronic device and a database of medical data.[7] Medical data is automatically received and there is no request made by the user for the data, *i.e.*, a 'push' system is established. The connection signal is any signal that signifies that a client-server relationship has been established between at least two remotely located electronic devices, such as over a network (a connection signal may be a HotSync® between a Palm® device and a remote server, for example). Therefore, the claimed invention does not require a system in which data is requested or 'pulled,' instead the data of the above-referred application is automatically 'pushed' by the server upon establishment of a connection between the client and the server. This ensures that the medical data on a physician's portable electronic device is always current. This technique of updating the client upon a connection signal between the client

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[3]   *Id.* at 3.

[4]   *See* Edelson col. 19, lines 51-53.

[5]   *See* Edelson, col. 46, lines 62-67.

[6]   *See* Bennahum, pgs. 2 and 3.

[7]   *See* Present Application, claims 1, 12, 17, and 22.

and server is not taught, suggested, or disclosed in either Edelson or Bennahum. Consequently, the Applicants respectfully submit that the amended independent claims 1, 12, 17, and 22 cannot be rendered obvious by the combination of Edelson and Bennahum.

Additionally, new claims 27-44 present subject matter originally disclosed in the specification but not previously claimed. For example, new claim 27 recites displaying an advertisement during the updating of the portable electronic device. For example, this advertisement may be displayed either on the desktop or on the portable electronic device. The prior art made of record does not disclose or suggest displaying advertisements while medical data is being updated on the portable electronic device. Claim 31 requires sending customized messages to the user during updating. The connection signal allows the server application to identify the particular user and access specific information about the particular user currently receiving updated medical data. Therefore, customized messages of particular importance or relevance can be sent to that user. Also, this sending of the customized messages is another example of a 'push' type electronic transaction, wherein the user does not have to request the messages. The prior art does not teach, suggest, or disclose a server application having the capability of sending customized messages to the user during updating.

Furthermore, new claim 34 recites that ownership of the portable electronic device remains with a sponsoring entity. This is an important feature because physicians are held to an ethical standard which prohibits them from receiving gifts higher than a certain value. Accordingly, because the sponsorship entity retains ownership, this assists the physician in maintaining an unbiased judgment when prescribing medications or providing other treatments to patients.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. Should the Examiner believe that a telephone interview would help advance the prosecution of this case, the Examiner is <u>encouraged</u> to contact the undersigned attorney at 650-849-7603.

If there are any fees or credits due in connection with the filing of this Amendment, authorization is given to charge any necessary fees to Morgan, Lewis & Bockius LLP's Deposit Account No. 50-0310 (Order No. 061018-0007-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Date: March 12, 2004   51,743
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